

Docket No.: M3653.0001/P001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sandra K. Richardson, et al

#32

Application No.: 09/334,256

Group Art Unit: 2155

Filed: June 16, 1999

Examiner: Forrest Thompson, Jr.

For: METHOD AND APPARATUS FOR
PLANNING AND MONITORING
MULTIPLE TASKS BASED ON USER
DEFINED CRITERIA AND PREDICTIVE
ABILITY

APPELLANT'S REPLY BRIEF

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, DC 20231

Dear Sir:

Pursuant to 35 U.S.C. § 134 and 37 C.F.R. 1.103 and in response to the
Examiner's Answer dated January 14, 2003, Appellants hereby submit in triplicate this
Reply Appeal Brief.

I. CLARIFICATION OF APPENDICES TO APPEAL BRIEF

Although the presence of Appendix B in the Appeal Brief filed on October 21,
2002 was mentioned briefly in section VIII. B. 1. a on page 9 thereof, Appellants wish to
clarify the nature and the purpose of the Appendices provided at the end of the Appeal
Brief for the record.

Appendix A is a complete listing of the most updated form of the claims on appeal, as is standard.

Appendix B is a complete copy of the Duncan reference cited against the claims, to enable the Board to assess the cited sections of the reference in their proper context within the reference. Also, since the entire reference was cited in the PTO-form 892 accompanying the Office Action dated September 8, 2000, but only selected pages were provided with the Office Action, Appellants believed it was appropriate that the application file include a complete copy of the reference as cited in the Office Action.

II. REBUTTAL STATEMENTS

As pages 3-14 of the Examiner's Answer constitutes a restatement of the final rejection, Appellants present the following statements in rebuttal to the arguments presented in section 12, entitled "Response to Argument," found at pages 14-18 therein.

A. APPLICANTS DEFINE THE INVENTION, NOT THE EXAMINER

Central to the issue of patentability in the present application is the definition of certain terms defined in Appellants' specification. The terms at issue include, *inter alia*, "tasking horizon" and "verb." When construed in the manner described in Appellants' specification and in sections VIII. A. 2. a. and VIII. A. 2. b. in the Appeal Brief filed on October 21, 2002, the claimed invention can be readily recognized as being significantly different and patentably distinguishable over Duncan, the cited reference. The final Office Action and the Examiner's Answer, however, have distorted Appellants' stated meanings of those terms in an attempt to justify the preconceived conclusion of obviousness over the Duncan reference.

A long standing, fundamental principle in patent law recognizes that applicants have the right to be their own lexicographers, and that generally, the applicant's meanings are binding. *See, e.g., Int'l Cork Co. v. New Process Cork Co.*, 6 F.2d 420, 422 (2d Cir. 1925) (holding that "[a] patentee may define his own terms, regardless of common or technical meaning, and fairness to the patentee requires the court to accept his definition of the words, phrases, and terms."); *accord., Esnault-Pelterie v. Chance Vought Corp.*, 56 F.2d 393, 406-407, 12 U.S.P.Q. 397 (E.D.N.Y. 1932). Thus, where an applicant or patentee has set forth definitions for claim terminology in the specification, the meanings are determined by the applicant or the patentee, not the Examiner. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 U.S.P.Q. 1025, 1031 (Fed. Cir. 1984) (stating that [i]t is the inventor applying for a patent who is permitted to be his own lexicographer.") (emphasis added). *See also* MPEP §§ 2111.01, 2173.01, 2173.05(a). An Examiner, therefore, is not allowed to change the meaning of an applicant's terms as he sees fit in order to force a prior art reference into meeting the redefined claims. Nevertheless, the final Office Action and earlier Office Actions have cast aside Appellants' stated definitions for terms such as "tasking horizon" and "verbs." Furthermore, the Examiner's Answer(dated January 14, 2003) alleges at the bottom of page 14, in response to Appellants' argument in the Appeal Brief that the final Office Action has misdefined several important terms of the claimed invention, that "Appellants have redefined the examiner's terms."

Although Examiners are permitted to interpret claim terminology more broadly than disclosed in the specification if the specification discloses more narrowing limitations which are not recited in the claims (MPEP § 2111), as "redefined" in the manner set forth in the final Office Action and Examiner's Answer, the terms "tasking horizon" and "verb" as recited in Appellants' claims are now rendered inconsistent with the specification and unworkable in the context of the invention as disclosed in the

application. Moreover, by changing the meaning of Appellants' terms to conform with the definitions preferred by the Examiner, the final Office Action and Examiner's Answer violate the requirement that "[d]uring patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" MPEP § 2111 (emphasis added).

B. IT IS CRITICAL THAT THE CLAIMS BE CONSTRUED IN LIGHT OF THE CORRECT MEANINGS OF THE CLAIM TERMINOLOGY.

1. The Examiner's Answer's revised definition of "tasking horizon" is still inconsistent with Appellants' specification.

As mentioned in section VIII. A. 2. a. in the Appeal Brief (filed October 21, 2002), Appellants' specification discloses that after a project is broken down into a plurality of tasks (*e.g.*, specification, p. 11, lns. 10-13; FIG. 4, block 14), planning for the project is performed, not for the whole project at once, but only for an upcoming increment of a much smaller, more realistic time window, termed the "tasking horizon." (specification, p. 11, lns. 19-26, esp. lns. 20-21) (*See also* specification, p. 6, lns. 9-13; p. 11, lns. 17-24). Each tasking horizon is thus a fixed window of time within which any of a plurality of tasks dates can be scheduled into or removed therefrom so that the progress of the various tasks in a project is measured with respect to this planning window. (*e.g.*, specification, p. 13, lns. 10-13; p. 15, lns. 15-16, 22-24) As such, the period of time encompassed by a tasking horizon is necessarily a window of time which is independent of any specific task in the project.

The final Office Action had changed the meaning of the term "tasking horizon" to the definition preferred by the Examiner, *i.e.*, "the duration of time included in the planned time span defined by the task start and stop dates." Section VIII. A. 2. a. and b. in Appellants' Appeal Brief demonstrated that the final Office Action's definition of

"tasking horizon" is inconsistent with Appellants' specification. Consequently, it appears that the Examiner's Answer has changed its "definition" of the term "tasking horizon" to be "the duration of time included in the planned time span defined by all of the start and stop dates for all of the tasks of a project or activity." (Examiner's Answer dated January 14, 2003, p. 15, lns. 1-2). Essentially, it appears that the Examiner's Answer now desires the term "tasking horizon" to be defined as the time period encompassing the entire duration of the whole project.

Again, this new "definition" is a misinterpretation of the term "tasking horizon" as specifically defined by Appellant in the specification, and as restated in the Appeal Brief. Specifically, if a "tasking horizon" is defined to encompass the time period between the start and stop dates of the entire project, then this would preclude the invention from breaking down the time frame of the project into smaller periods of time for planning purposes as discussed on page 11, lines 19-22, since this cited passage defines such smaller time periods as the tasking horizon.

The Examiner's Answer further mentions the performance of an activity within the context of Duncan. Although the logic in the Examiner's Answer here is unclear, it appears that it may be attempting to portray yet another "definition" of the term "tasking horizon" in terms of the start and stop dates of an activity. The Examiner's Answer appears to rely on the glossary definition of the word "activity" in Duncan, which includes the statement that "[a]ctivities are often subdivided into tasks."

Assuming *arguendo* that an "activity" in Duncan corresponds with Appellants' "tasking horizon," based on the definition set forth on page 159 of Duncan, as cited in the Examiner's Answer, this "definition" of the "tasking horizon," like the other two versions proffered in the final Office Action and the Examiner's Answer, also fail with respect to the claimed invention. If an activity is subdivided into tasks, as described in the glossary definition of "activity" in Duncan, then an activity is necessarily defined by

the performance of those tasks. If any of the tasks within an activity are delayed, then the stop date of the activity is also delayed, because no task date can fall outside of the time period between the start and stop dates of the activity. This is so because if any of the tasks within an activity are unfinished, then by definition, the activity is unfinished. Thus, the time window defined by the activity start and stop dates cannot represent a task-independent fixed time window into and out of which tasks can be moved. This is again contrary to the meaning of Appellants' "tasking horizon" as defined in the specification and exactly the same situation explained in section VIII. A. 2. b. in the Appeal Brief filed on October 21, 2002.

2. The Examiner's Answer's position that the claim element identified by the term "verb" is met by Duncan's glossary is not convincing.

In section VIII. A. 3. in the Appeal Brief, Appellants explained that the term "verb" used in the present invention is part of a predefined and structured set or sets of words and phrases (or reasons) that have been programmed into the modeling system of the present invention. (Figure 4; specification p. 12, lns. 15-18, p. 12, ln. 22 – p. 13, ln. 6). A further demonstration supporting the meaning of the term "verb" is set forth from page 11, line 16 through page 12, line 15 in Appellants' specification, and also in FIG. 4 and accompanying description in the application (showing the selection of verbs 18 to occur after the step of identifying a tasking horizon 16 and before the step of assigning tasks to be performed by project personnel 20).

Lines 4-7 on page 15 of the Examiner's Answer asserts that "Duncan discloses a Glossary of terms (see pg. 157) that may be used with the Duncan invention and that encompasses presenting verbs (and other terms) used during the various stages of an activity or project." This Glossary which "presents verbs" is nothing more than a glossary of relevant terms used throughout the book (Duncan). There is absolutely

nothing selective about the words defined in Duncan's glossary which corresponds with Appellants' specifically defined term "verb," i.e., a predefined set of words or phrases programmed into a modeling system, prior to the start of the any work being performed on the project, such that each success and/or failure in meeting interim goals can be explained by selecting from the predefined set of words or phrases. Moreover, nowhere in Duncan is there a term having a meaning which resembles Appellants' meaning of the term "verb." Therefore, the "verb" or "verbs" as recited in Appellants' claims are far from being anticipated or rendered obvious by Duncan.

C. APPELLANTS' CLAIMED INVENTION IS NOT RENDERED OBVIOUS BY DUNCAN

1. Neither the final Office Action nor the Examiner's Answer demonstrates any suggestion in Duncan of each and every specific and distinct feature of the claimed invention.

At the top of page 16, the Examiner's Answer contends that "the disclosures of Duncan as identified in the Final Action, while not identical to those of Appellants, disclose Appellants' invention" (emphasis added). In other words, the Examiner's Answer maintains that while Duncan does not disclose the claimed invention, it somehow still discloses it. This position is not understood.

Yet the final Office Action and Examiner's Answer fail to demonstrate any suggestion or motivation for modifying Duncan in accordance with Appellants' claimed invention. Moreover, in many instances, elements which are identified in Duncan as meeting various elements of Appellants' claims are simply are derived from the erroneous "definitions" of Appellants' claim terminology which are unworkable in the context of Appellants' invention as disclosed in the specification, and in other instances

are interpreted out of context in Duncan, and thus not truly corresponding to the elements of Appellants' claims as proffered in the final Office Action.

- a. *Many claim elements of Appellants' invention are not met by Duncan because the claim elements have been attributed an incorrect meaning which renders the terms unworkable within the context of Appellants' disclosed invention.*

On page 5 in the Examiner's Answer and on pages 6-7 in the final Office Action, it is conceded that Duncan does not disclose calculating churn as recited in claim 1. The meaning of "churn" is demonstrated, for example, on page 16, lines 1-13 in the specification, by the movement of task dates into and out of a particular tasking horizon being analyzed at that point in time. As discussed above and in the Appeal Brief, the meaning of the term "tasking horizon" has been misdefined and improperly applied in the final Office Action and Examiner's Answer.

To overcome the fact that Duncan fails to teach churn as recited in claim 1, the final Office Action notes that Duncan discloses "tools to perform variance analysis involving comparing actual project results to planned or expected results, trend analysis, earned value analysis, performance reports, changes requests," and then asserts that "it would have been obvious . . . to modify Duncan to disclose the functionality necessary to calculate [churn as recited in the claim]." (final Office Action, page 6; Examiner's Answer, page 7) . No explanation whatsoever is given as to how Duncan enables one of ordinary skill in the art to make the creative leap from the "tools to perform variance analysis" disclosed in Duncan to the concept of churn as defined and claimed in the present application, especially when an improper definition is used for the term "tasking horizon" from the outset.

Similarly, the rejection rationales set forth for claims 9 and 23, 10 and 22, 17 and 20 each concede that Duncan does not teach churn, but then "overcomes" that shortcoming in the same manner, by alleging that Duncan "discloses the functionality" of the claimed invention. Since these rejection sections also lack explanation of how "churn" is suggested in Duncan or how (or where) Duncan provides motivation to be modified in accordance with the claimed invention, the rejections of these claims suffer from the defect demonstrated above in the rejection of claim 1.

- b. *Many claim elements are not met by Duncan because the allegedly corresponding elements in Duncan are interpreted out of context within Duncan and do not truly correspond with the elements of Appellants' claims.*

The Examiner's Answer alleges, from the bottom of page 17 through the top of page 18, that section 11.4 as shown in Fig. 3-6 on page 33 in Duncan corresponds to the "assigning a risk factor" as recited in claims 9 and 23 of Appellants' claims. Upon close examination of this feature in Duncan, however, it becomes readily apparent that this feature involves a very different concept than the "assigning a risk factor" as claimed in the present application.

As noted in section VIII. B. 1. e. in the Appeal Brief filed on October 21, 2002, the term "risk factor" represents either percentage probability that an actual task date will deviate from the estimated task date, or a standard deviation within which the actual task date is likely to vary from the estimated date. In other words, the risk factor is simply a number associated with a particular task date.

Section 11.4 is not found in Fig. 3-6 in Duncan as referenced in the Examiner's Answer, but is found on page 33 in the text underneath the figure. Here, Duncan indicates that section 11.4 refers to a process of "risk response control," defined as

"responding to changes in risk over the course of the project." Turning to section 11.4 on page 121 in Duncan, the closest feature within section 11.4 to "assigning a risk factor" is subsection 11.4.1.3, entitled "additional risk identification." This process, however, identifies a risk event or source of risk. A "risk event" is defined in the Glossary (page 169 in Duncan) as a "discrete occurrence that may affect the project for better or worse." The discussion of risk events in section 11.4.1.2 on page 121 states that "[s]ome of the identified risk events will occur, others will not." Thus, these features related to risk in Duncan are directed towards the identifying events or occurrences that may affect the project. An event or occurrence is not a number, as is the "risk factor" recited in Appellants' claims 9 and 23. In view of this analysis of the risk response control in Duncan, it is clear that Duncan's disclosures relating to risk are significantly different from the assigning of a risk factor to a task date as claimed in the present application.

2. The "functionality" of Duncan does not provide any suggestions or motivations to adopt the specific features as recited in Appellants' claims.

The final Office Action repeatedly uses the word "functionality" for bridging the gap between the claimed invention and the process disclosed in Duncan. Although the final Office Action (restated in pages 4-14 in the Examiner's Answer) concedes that Duncan does not teach many of the features recited in Appellants' claims, the final Office Action "overcomes" the differences between Duncan and the claimed invention by simply dismissing those differences as being "encompassed" by the "functionality" of Duncan. (See rejection rationales for claims 1, 9, 10, 17, 20, 22, and 23). More specifically, the final Office Action asserts, in the rejection sections for each of claims 1, 9 and 23, 10 and 22, 17, and 20 that Duncan "discloses the functionality" for performing the claimed process (computing churn) or encompassing the claimed apparatus. The

same rationale is presented in the last paragraph on page 16 and in the last paragraph on page 18 of the Examiner's Answer. The last paragraph on page 18 of the Examiner's Answer appears to indicate that the "functionality and comparable aspects and capabilities" of Duncan render obvious Appellants' claimed invention because "[b]oth inventions address the conduct of project management planning and activities."

The common "conduct of project management planning an activities" is hardly a justification for resolving the significant distinctions between Duncan and the claimed invention absent any teaching or suggestion of each and every specific feature of the claimed invention. All project management processes, plans, etc. share the same goals of cost efficiency, time efficiency, and effectiveness in the planning, scheduling, and execution of the project, from start to finish. Such broad goals, however, do not motivate one of ordinary skill in the art to adopt the specific features of Appellants' claimed invention which make it unique with respect to Duncan, and indeed all other project management plans, processes, etc., without the improper application of hindsight knowledge of Appellants' invention.

3. Duncan does not teach or suggest Appellants' claimed invention as a whole.

As the Board is well aware, in order to properly reject the claims under obviousness, the claimed invention, as a whole, must be taught or suggested in the prior art. However, when one of ordinary skill in the art backs away from attempting to match up specific details of the claimed invention with specific details of Duncan and instead considers the general fabric of the project management guide disclosed in Duncan next to the general fabric of the project management method and apparatus disclosed and claimed in the present application, it is clear that the two are clearly and irreconcilably distinct from one another. Specifically, Duncan is a generalized outline or

guide to be used as a reference for a project manager in managing a project. The claimed invention, however, is an actual method and apparatus for implementing project management, which relies on human input and interaction with a computer software and/or network environment. The level of detail involved with the performance and operation of the claimed invention is simply not contemplated in the overview guide disclosed in Duncan.

D. CONCLUSION

For all of the reasons discussed in this Reply Brief, Appellants respectfully submit that the final rejection of obviousness over Duncan is untenable, and that the present invention as recited in claims 1-23 are allowable. Accordingly, reversal of the rejection under 35 U.S.C. 103 is courteously solicited.

Dated: March 14, 2003

Respectfully submitted,

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